

## REMARKS

This Response is submitted in response to the Office Action mailed on June 16, 2004. In the Office Action, all of the pending claims, Claims 1-14, 16-24, 26-43, 69-84, 90-93, and 102-110, are rejected under 35 U.S.C. § 103. Applicants respectfully submit for the reasons set forth below, that these rejections are not proper as a matter of law or fact. Therefore, Applicants respectfully request the rejections be withdrawn.

The above-identified claims stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent Nos. 6,550,582 (*Addy*) in view of U.S. Patent No. 4,645,036 (*Nestler*). Generally, the basis of the rejection is that *Addy* “discloses a typical supermarket checkout counter with a pre-scan area 12, and itemization area 14, a payment area 16, and a post-scan area 18.” *Nestler* “discloses a product dispenser at a checkout counter and its associated control elements...[i]t would have been obvious to a person of ordinary skill in the art at the time of the invention to include the product dispenser of *Nestler* with the checkout counter of *Addy*. As clearly taught by *Nestler*, this would be useful for discouraging theft and provide easy access to the checkout clerk or store patron at checkout.” See pages 2 and 3 of the Office Action.

Applicants respectfully submit that this rejection is not proper. Indeed, the Office Action must, it is respectfully submitted, mischaracterize the *Nestler* reference in order to even attempt to make out an obviousness rejection. In this regard, Applicants note for the record that *Nestler* does not “provide easy access to the...store patron at checkout.” The dispenser of *Nestler* is designed for use by the store operator only. In fact, the dispenser prevents patron access. Thus, as noted below, a plethora of claims are not only not even arguably taught by the cited references, they are actually taught away from by same. Furthermore, Applicants respectfully submit there is no motivation to combine *Addy* and *Nestler*.

Each of Claims 9-14, 16-24, 34-41, 69-73, 75, 79, 103, 106, 107, and 108 provides a point of purchase dispensing device, or similar apparatus, that dispenses an item in response to an input from the customer. Indeed, a number of the claims, for example independent Claim 9, requires a device that can be operated without the need for a cashier. In contrast, *Nestler* discloses a device that requires a retail operator to operate the dispensing device. In fact, the purpose of the dispensing device of *Nestler* is to prevent the customer from being able to access the product without the retailer operator’s input. Accordingly, the above-identified claims are taught away from the combination of *Nestler* with *Addy*.

Moreover, Claims 80-84 and 90-93 require elements that are not disclosed nor even arguably suggested by the combined references. In this regard, a communication device that communicates accumulated inventory information related to the product to a remote location (Claims 90-93) and a communication device that allows information relating to the product to be communicated to the remote location (Claims 80-84) are recited by these claims and not even arguably hinted at by the cited references. Indeed, the Patent Office has not discussed either of the above-identified features in making the rejection. Therefore, as a matter of fact, these claims are allowable over the cited references as each and every one of these claims includes elements that are not remotely disclosed or suggested by the cited references.

With respect to the remaining claims, the alleged combination of the two references is currently based on a hindsight reconstruction of the claimed invention. In this regard, the purpose of *Addy* is to reduce employees. “What is particularly needed is a self-service checkout terminal which allows the customer to checkout a relatively large item order without intervention from retail personnel.” See column 2, lines 17-20. Indeed, it is an object of the invention of *Addy* to provide a self-service checkout terminal which allows a customer to checkout without any intervention from retail personnel. See column 3, lines 44-52.

In contrast, *Addy* relates to a device that requires a clerk’s intervention in order to obtain certain products. Thus, combining *Nestler* with *Addy* would destroy the invention of *Addy*. Accordingly, the two references teach away from the proposed combination suggested by the Patent Office. One requires no retail operator and the other requires a retail operator.

Still further, the alleged motivation for the combination is also lacking. In a self-service checkout counter such as that disclosed in *Addy*, as noted in Applicants’ patent application, no point of purchase products are provided. Thus, the issues of theft and storage that are specifically addressed by *Nestler* are not present in *Addy*. Therefore, there is no motivation to combine *Addy* with *Nestler* as *Addy* relates to a self-service checkout counter that does not have point of purchase products. The Patent Office’s attention is directed to the figures of *Addy* where no point of purchase products are illustrated.

Accordingly, the obviousness rejection is not proper in that: (1) there is no motivation for the combination of the references; and (2) the combination of the references is taught away from by each of the references as the proposed combination would destroy each of the alleged inventions.

Therefore, Applicants respectfully request, for the reasons set forth above, that the rejection of the pending claims be withdrawn. In the first instance, the majority of the claims include elements that the Patent Office does not even address in the rejection. In the second instance, the proposed combination of the two references is not proper and is based on a hindsight reconstruction of the claimed invention.

For the foregoing reasons, Applicants respectfully request reconsideration of their patent application and earnestly solicit an early allowance of same.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY 

Robert M. Barrett  
Reg. No. 30,142  
P.O. Box 1135  
Chicago, Illinois 60690-1135  
Phone: (312) 807-4204

Dated: September 15, 2004